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Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NAHAR, QAMRUN

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 12/31/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,078

Applicant(s)

BOHAN, DAVID

Examiner

Qamrun Nahar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is in response to the amendment filed on 8/7/03.
2. The objections to the abstract are withdrawn in view of applicant's amendment.
3. The objections to the disclosure are withdrawn in view of applicant's amendment.
4. The objection to claim 8 is withdrawn in view of applicant's amendment.
5. The rejection under 35 U.S.C. 112, second paragraph, to claim 10 is withdrawn in view of applicant's amendment.
6. The rejections under 35 U.S.C. 102(b) as being anticipated by Hendrickson (U.S. 5,933,646) are withdrawn in view of new grounds of rejection.
7. The rejections under 35 U.S.C. 103(a) as being unpatentable over Hendrickson (U.S. 5,933,646) in view of Tsukamoto (U.S. 5,857,073) are withdrawn in view of new grounds of rejection.
8. The rejections under 35 U.S.C. 103(a) as being unpatentable over Hendrickson (U.S. 5,933,646) in view of Sampath (U.S. 6,266,774) are withdrawn in view of new grounds of rejection.
9. The rejections under 35 U.S.C. 103(a) as being unpatentable over Hendrickson (U.S. 5,933,646) in view of Gottsman (U.S. 6,134,548) are withdrawn in view of new grounds of rejection.
10. Claims 21-30 have been added.
11. Claims 5-8, 10-13 and 18-20 have been amended.
12. Claims 1-30 are pending.

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13. Claims 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

14. Claims 1-4, 8-10, 14-17 and 21-30 are rejected under 35 U.S.C. 102(e) as being anticipated by "Web390 for OS/390 and MVS", Information Builders, Inc., 1999 (hereinafter IB).

15. Claims 5, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Web390 for OS/390 and MVS", Information Builders, Inc., 1999 (hereinafter IB) in view of Tsukamoto (U.S. 5,857,073).

16. Claims 6, 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Web390 for OS/390 and MVS", Information Builders, Inc., 1999 (hereinafter IB) in view of Sampath (U.S. 6,266,774).

17. Claims 7, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Web390 for OS/390 and MVS", Information Builders, Inc., 1999 (hereinafter IB) in view of Gottsman (U.S. 6,134,548).

Response to Amendment

Claim Objections

18. Claim 27 is objected to because of the following informalities: "The method of Claim 25" should be "The medium of Claim 25". Appropriate correction is required.

19. Claim 30 is objected to because of the following informalities: "by providing the providing" on line 5 of the claim should be "by providing". Appropriate correction is required.

Claim Rejections - 35 USC § 101

20. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

21. Claims 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 28, merely claimed as a program representing a computer listing *per se* (plug-in module), that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical “thing” nor a statutory process, as there are not “acts” being performed. Such claimed programs do not define any structural and functional interrelationships between the program and other claimed aspects of the invention which permit the program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the program’s functionality. In contrast, a claimed computer-readable medium encoded with a program defines structural and functional interrelationships between the program and the medium which permit the program’s functionality to be realized, and is thus statutory.

Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

It is suggested that claim 28 be amended to recite the claimed plug-in module as “a computer readable medium storing one or more plug-in modules”.

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As per claims 29-30, these claims are rejected for dependency on the above rejected non-statutory claim 28.

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

23. Claims 1-4, 8-10, 14-17 and 21-30 are rejected under 35 U.S.C. 102(e) as being anticipated by “Web390 for OS/390 and MVS”, Information Builders, Inc., 1999 (hereinafter IB).

Per Claim 1:

The IB publication discloses:

- **a method of providing an access to one or more third party legacy data list to a user of an application program of a computer system (“Web390 for OS/390 and MVS ... Access Legacy Data and 3270 Applications From the Web” in Title and pg. 1, par. 1, lines 1-14)**
- **querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating**

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system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list; receiving, from said one or more plug-in modules found in said registry, identifications of one or more third party legacy data list corresponding to said found one or more plug-in modules; and providing a list of said identifications to said user through a user interface of said application program (“Users can choose one of several presentation options at runtime. Those familiar with 3270 terminals but new to the Web can select 3270 Emulation Mode, which employs a Netscape Navigator plug-in to deliver the familiar 3270 green screens to the browser windows. Those familiar with the Web can select HTML Translation Mode, which automatically converts 3270 datastreams into HTML forms, allowing users to interact using familiar radio buttons and scrolling data entry windows.” on pg. 1, par. 5, lines 1-6 and par. 6, lines 1-6; inherently teaches querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system).

Per Claim 2:

The IB publication discloses:

- adding to said computer system one or more additional plug-in module capable of interfacing with one or more additional third party legacy data list; and registering said one or more additional plug-in modules in said registry of said operating system, said application program being configured to find said one or more additional plug-in modules

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when said application program is started after said addition of said one or more additional plug-in modules (on pg. 2, par. 1, lines 1-6).

Per Claim 3:

The IB publication discloses:

- allowing said user to select a selected one of said one or more third party legacy data list from said list of identifications; and allowing said user to edit at least one datum of said selected one of said one or more third party legacy data list through an edit user interface of said selected one of said one or more third party legacy data list, said application program communicating with said selected one of said one or more third party data list through corresponding one of said one or more plug-in module (on pg. 2, par. 2, lines 1-9).

Per Claim 4:

The IB publication discloses:

- allowing said user to select a selected one of said one or more third party legacy data list from said list of identifications; and allowing said user to access at least one datum of said selected one of said one or more third party legacy data list through said user interface of said application program, said application program communicating with said selected to said one of said one or more third party legacy data list through corresponding one of said one or more plug-in module (on pg. 2, par. 2, lines 1-9).

Per Claim 8 (Amended):

This is a system version of the claimed method discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim is also anticipated by IB.

Per Claim 9:

This is a system version of the claimed method discussed above, claim 2, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “an installer software” (on pg. 3, par. 3, lines 7-8). Thus, accordingly, this claim is also anticipated by IB.

Per Claim 10 (Amended):

The IB publication discloses:

- said user interface is configured to allow said user to select a selected one of said one or more third party legacy data list (on pg. 3, par. 1, lines 1-7).

Per Claims 14-17:

These are computer readable storage medium versions of the claimed method discussed above (claims 1-4, respectively), wherein all claim limitations also have been addressed and/or

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covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by IB.

Per Claim 21 (New):

The IB publication discloses:

- **a method of providing an application program with access to a third party legacy data list not supported by the application program** (“Web390 for OS/390 and MVS ... Access Legacy Data and 3270 Applications From the Web” in Title and pg. 1, par. 1, lines 1-14)
- **supplying a plug-in module capable of providing an interface between the application program and the third party legacy data list; the application program sending a function call to the plug-in module; the plug-in module, in response to the function call, accessing the third party legacy data list and providing the application program information relating to the third party legacy data list** (“Users can choose one of several presentation options at runtime. Those familiar with 3270 terminals but new to the Web can select 3270 Emulation Mode, which employs a Netscape Navigator plug-in to deliver the familiar 3270 green screens to the browser windows. Those familiar with the Web can select HTML Translation Mode, which automatically converts 3270 datastreams into HTML forms, allowing users to interact using familiar radio buttons and scrolling data entry windows.” on pg. 1, par. 5, lines 1-6 and par. 6, lines 1-6).

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Per Claim 22 (New):

The IB publication discloses:

- wherein accessing comprises accessing a data set from the third partly legacy data list, and providing comprises providing the application program with the data set (on pg. 1, par. 5, lines 1-6 and par. 6, lines 1-6).

Per Claim 23 (New):

The IB publication discloses:

- further comprising the application program displaying at least a portion of the data set in a user interface (on pg. 2, par. 2, lines 1-9).

Per Claim 24 (New):

The IB publication discloses:

- wherein accessing comprises accessing a data set from the third party legacy data list and providing comprises providing the application program with information required to present a user interface for adding datum to, modifying datum within, and deleting datum from the data set (on pg. 2, par. 2, lines 1-9).

Per Claims 25-27 (New):

These are computer readable medium versions of the claimed method discussed above (claims 21-22 and 24, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by IB.

Per Claims 28-30 (New):

These are plug-in module versions of the claimed method discussed above (claims 21-22 and 24, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by IB.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 5, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Web390 for OS/390 and MVS”, Information Builders, Inc., 1999 (hereinafter IB) in view of Tsukamoto (U.S. 5,857,073).

Per Claim 5 (Amended):

The rejection of claim 4 is incorporated, and further, IB does not explicitly teach that the application program comprises a facsimile software or the one or more third party legacy data

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list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software.

Tsukamoto teaches that the application program comprises a facsimile software (column 4, lines 10-18) and the one or more third party legacy data list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software (column 5, lines 16-65; column 11, lines 14-16; and Fig. 5).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by IB to include that the application program comprises a facsimile software and the one or more third party legacy data list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software using the teaching of Tsukamoto. The modification would be obvious because one of ordinary skill in the art would be motivated to update software components comprising contact information.

Per Claim 11 (Amended):

This is a system version of the claimed method discussed above, claim 5, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim is also obvious.

Per Claim 18 (Amended):

This is a computer readable storage medium version of the claimed method discussed above, claim 5, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

26. Claims 6, 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Web390 for OS/390 and MVS”, Information Builders, Inc., 1999 (hereinafter IB) in view of Sampath (U.S. 6,266,774).

Per Claim 6 (Amended):

The rejection of claim 4 is incorporated, and further, IB does not explicitly teach that the application program comprises an e-mail software or the one or more third party legacy data list comprise one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software. Sampath teaches that the application program comprises an e-mail software (column 4, lines 33-43) and the one or more third party legacy data list comprise one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software (column 6, lines 15-18).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by IB to include that the application program comprises an e-mail software and the one or more third party legacy data list comprise one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software using the teaching of

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Sampath. The modification would be obvious because one of ordinary skill in the art would be motivated to update software components comprising contact information.

Per Claim 12 (Amended):

This is a system version of the claimed method discussed above, claim 6, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim is also obvious.

Per Claim 19 (Amended):

This is a computer readable storage medium version of the claimed method discussed above, claim 6, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

27. Claims 7, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Web390 for OS/390 and MVS", Information Builders, Inc., 1999 (hereinafter IB) in view of Gottsman (U.S. 6,134,548).

Per Claim 7 (Amended):

The rejection of claim 4 is incorporated, and further, IB does not explicitly teach that the application program comprises a personal organizer software or the one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal

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organizer software. Gottsman teaches that the application program comprises a personal organizer software and the one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal organizer software (column 37, lines 5-12).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by IB to include that the application program comprises a personal organizer software and the one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal organizer software using the teaching of Gottsman. The modification would be obvious because one of ordinary skill in the art would be motivated to update software components comprising contact information.

Per Claim 13 (Amended):

This is a system version of the claimed method discussed above, claim 7, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim is also obvious.

Per Claim 20 (Amended):

This is a computer readable storage medium version of the claimed method discussed above, claim 7, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Response to Arguments

28. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The IT Update's article "Information Builders Brings The Mainframe To The Internet/Intranet", 1996, discloses that Web390 replaced Web3270's functionality on page 2, par. 2, lines 1-6.

Bowman-Amuah (U.S. 6,571,282) discloses "Web3270 – a plug-in from Information Builders that allows mainframe 3270-based applications to be viewed across the Internet from within a browser. ... Interest in Web3270 and similar plug-ins has increased with the Internets ability to provide customers and trading partners direct access to an organizations applications and data. Screen scraping plug-ins can bring legacy applications to the Internet or intranet very quickly." in column 44, lines 54-64.

30. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

QN
December 22, 2003

Kakali Chaki
**KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**